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In the Supreme Court of the United States

OCTOBER TERM, 1965.

No. 1092.

UNIVERSAL MARION CORPORATION,

Petitioner,

vs.

THE WARNER & SWASEY COMPANY, *et al.,*

Respondents.

BRIEF OF RESPONDENTS, THE WARNER & SWASEY COMPANY, ET AL., In Opposition to Petition for Writ of Certiorari.

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OPINIONS BELOW.

The opinion of the Court of Appeals for the Tenth Circuit is reported at 354 F. 2d 541, and appears on pages 2a to 9a of the Appendix to the Petition. The decision constituting the findings of fact and conclusions of law of the United States District Court for the District of Colorado are reported at 23 F. Supp. 719, and appear on pages 11a through 63a of the Appendix.

JURISDICTION.

The jurisdictional requisites are adequately set forth in the Petition.

QUESTIONS PRESENTED.

I. Question I as presented by Petitioner presents no question other than: Is the decision of this Court in *Elizabeth v. Pavement Co.*, 97 U. S. 126 (1877), applicable today to determine whether or not a use of an invention in public was an experimental use or a "public use" in contravention to the statute? This question assumes, without support in the record, that Petitioner established a use in public, before May 15, 1943, of a completed invention. Moreover, the record does not support Petitioner's characterization of the use which occurred as an "admittedly * * * commercial exploitation."

II. Question II as presented by Petitioner is hypothetical in that it presupposes, without any support in the record, that the District Court found that a completed invention was used in public and, after so finding, found that the use was experimental by applying a presumption in favor of Respondents. The discussion of this issue by the District Court clearly shows that no presumption was applied. Moreover, there is nothing in the record to suggest that the Court of Appeals applied a presumption in favor of Respondents.

In support of the lower court's judgment, Respondents will argue, if certiorari is granted, that Petitioner had not carried its burden of showing that the invention was completed and thereafter in public use prior to May 15, 1943.

CONSTITUTIONAL PROVISIONS AND STATUTES INVOLVED.

These provisions are adequately set forth in the Petition.

STATEMENT OF THE CASE.

Background.

This action was brought by The Warner & Swasey Company, exclusive licensee of Patent No. 2,541,045, along with the owners of the patent, against Universal Marion Corporation, for their manufacture and sale of a "Grademaster" excavating and grading machine. In the District Court, Petitioner contended that the patent was not infringed and was invalid as (1) failing to define a patentable invention over the prior art and (2) by reason of a prior public use of the invention at Ravenna more than one year prior to the filing of the patent application contrary to the provisions of 35 U. S. C. 102(b). The District Court found that the patent was infringed, was patentable over the prior art and that there was no prior public use as to invalidate the patent. Petitioner appealed the decision on validity and the Court of Appeals for the Tenth Circuit affirmed the District Court. Petitioner then filed its petition for a writ of certiorari and directed the questions to the defense of public use.

The public use defense raised by Petitioner is based on the trying of a prototype machine at Ravenna, Ohio between mid-March 1943 and May 15, 1943, the application having been filed on May 15, 1944. In the spring of 1943, the inventors, Ray and Koop Ferwerda, were working on a government arsenal project at Ravenna which had been underway for some time. While the record is not clear as to the extent of the use before May 15, 1943, the

record supports and the District Court held that the machine was used about six weeks during a three month period which extended from about mid-March to mid-June 1943 (Appendix 16a). Any use before May 1943 would have been more than one year before the filing of the application. The District Court held any such use to be experimental only, stating:

> "Although the invention saw some limited use for more than one year prior to the application, it was not in 'public use' within the intended meaning of 35 U. S. C. § 102(b)." (Appendix 44a.)

The burden of proving public use was Petitioner's. 35 U. S. C. § 282.

Invention.

The invention of the patent in suit taught the use of a rotatable telescoping boom in an excavating and grading machine for supporting and operating an implement, such as a bucket. The rotation of the boom allows the implement to be rotated about the boom axis so as to tilt the implement for working at various angles. In addition, the implement in the patented machine is mounted on the end of the boom for movement in a "wrist action" about an axis extending cross-wise of the boom. This coupled with boom rotation and mechanism for telescoping the boom, raising and lowering the boom and swinging the boom horizontally provides five distinct movements which enable the machine to accomplish the various purposes for which it was intended.

Machine at Ravenna Did Not Have Patented Features.

The patent claims in suit not only include the concept of the novel rotatable telescopic boom but certain claims also include the features of the wrist action at the end of the boom (claims 8 and 16, Annex A, pp. 26, 27) and an annular track or cradle which supports the telescopic boom for rotation (claim 9, Annex A, pp. 26-27). The record is clear that the machine which was tried out at Ravenna for a limited time immediately preceding the critical date did not have these features (Annexes C, D, E, F; pp. 30-34).

Development of Invention and Test at Ravenna.

As found by the District Court (Appendix 15a, 16a), the Ferwerdas built their first machine in the fall of 1942 and tried it out very briefly on a road project on Route 306 in Ohio. While this machine had the concept of a rotatable telescopic boom, it did not have the annular cradle or track or the wrist action of the patented machine. The boom of the first machine included several telescoping channel-like sections and an overhead boom for supporting the telescoping sections (Annex B, p. 29). Following an hour-long experimental application in the fall of 1942, the first machine was returned to the shop for modification, after which it was again used for about an hour or an hour and a half and was still found to be unsatisfactory.

During the winter of 1942-43 additional changes were made in the machine. The inventors removed the channel-type telescoping boom and replaced it with a completely different boom, a "three point suspension" boom, of the type shown in the patent. This boom structure did not include an overhead boom (Annex B, p. 29). The modified machine was then taken to a construction project at

the Ravenna Arsenal which, at that time, had been underway for over four and one-half months (Appendix 70a) and tried out (Appendix 64a). The machine was only one of many pieces of equipment on the construction project where, as found by the District Court, there were about ten bulldozers, six scrapers and tractors, shovels and cranes, and about twenty-five or thirty other pieces of equipment on the job (Appendix 18a). The machine was used for about six weeks during a three-month period extending from about mid-March to mid-June to grade two miles of berms and ditches and was down about 25% of the time during which time changes were made as found by the District Court (Appendix 16a).

While changes were made in the machine at Ravenna, more importantly, immediately after Ravenna, the machine was completely redesigned and the features of the annular track and wrist action were *for the first time* incorporated into the design. The annular track, the element which supports the novel rotatable telescopic boom, is specifically set out in patent claim 9 (Annex A, pp. 26-27). The wrist action, which greatly improves the efficiency and utility of the machine, is specifically recited in patent claims 8 and 16 (Annex A, pp. 26, 27). The patent application was filed at the most no later than six months from the time that the final design was completed and included these important features and changes.

Machine at Ravenna Under Control of Inventors.

During the time that the machine was used at Ravenna, the machine was under the control of the inventors (Appendix 64a). At no time prior to May 15, 1943 did anyone sell or license or attempt to market any machine. No production drawings were made. No direct financial return was received for the use of any machine; the en-

tire payment was for construction work on which the machine was used at contractors' option along with much of their equipment.

Documentary Evidence.

The record includes documentary evidence which substantiates the testimony of co-inventor Ray Ferwerda with regard to the development of the patented machine. Photographic evidence (Annex B, p. 29) establishes the structure of the first machine and documents the fact that it did not have the wrist action or the annular cradle feature of the invention. Photographs (Annexes C, D, and E, pp. 30, 31, and 32) also show the structure of the machine which was used at Ravenna and a comparison of these photographs and the photograph of the earlier machine establishes the described change in structure.

Not only was the structure of the machine documented by the photographs but the very paper so heavily relied upon by Petitioner in arguing public use is documentary evidence which clearly establishes that the use was not before mid-March 1943 (Appendix 70a).

The patent drawings document the changes which were made as a result of the use at Ravenna. Moreover, the inventors made an oath when the patent application was filed in 1944 that no public use had occurred.

Testimony as to Experimental Nature and Need for Testing.

Not only did the District Court have the opportunity to consider the testimony of one of the inventors, Ray Ferwerda, who testified, Appendix 64a, that the machine at Ravenna was being "tried out," that the inventors did not find the machine "satisfactory," or "marketable" and that it was "re-engineered," but it also had the benefit of evi-

dence and testimony from witnesses of both Petitioner and Respondents concerning the necessity for testing a machine of the type involved in the Ferwerda patent.

Mr. Nichols, Respondents' expert, testified (R. 171):

> "Q. Mr. Nichols, would a period of six months of testing of a new machine, where the basic design involves innovations over machines previously introduced of some substantial nature be an excessive period to field test a machine in the excavating industry? A. It would be very short.
>
> Q. Would one year be an extensive period of time? A. No, it wouldn't.
>
> Q. Would two months be a short time? A. Extremely short."

Mr. Baron, Petitioner's employee and expert, testified as to the comparable testing of Petitioner's Grademaster (R. 152-153):

> "Q. In other words, they [Grademasters] have not been out in the field working? A. They have been working under test.
>
> Q. How long have they been working under test? A. I would say almost—no, approximately six months.
>
> Q. Approximately six months. A relatively short time? A. Day and night operation.
>
> Q. Oh, six months day and night operation? Does this give you an indication whether it will hold up? A. In a stone quarry, yes."

In a report on Utilo-Scope or Choremaster, a machine for performing functions similar to those of the machine of the patent, which the Petitioner's predecessor had attempted to develop in 1949, Mr. Knutson, Petitioner's former employee, had said (Exh. 17, R. 203):

> "A definite 'must' on any new machine would be a thorough, complete, rugged, exhaustive testing under

actual operating conditions, before the machine is released for manufacture or even before components are bought in quantities."

Mr. Knutson testified at trial (R. 197):

"Q. (Continued) I refer you to the statement, 'A definite must on any new machine,' and it continues on. Right after the numeral 12, do you have the part I am referring to? Do you recall in your—was that your honest opinion at the time you wrote it? A. That a definite must would be an exhaustive testing?

Q. Yes. A. Yes, it was.

Q. And do you consider that an exhaustive testing could be done in two or three months? A. Not really, no.

Q. Under what conditions would the testing have to be done? A. Under actual contractors' field conditions, the actual on-the-job work being performed.

Q. Would six months be an extensive test period? A. Possibly, if enough work was encountered.

Q. It depends upon the amount of work that the machine was doing? A. That's right.

Q. Night and day for six months, would that be a pretty good indication? A. Yes, it would. All depends upon the work performed."

Decision.

After setting out the facts in its opinion, the District Court noted the decision of Judge Bratton in *Merrill v. Builders Ornamental Iron Co.*, 197 F. 2d 16, at pp. 18-19 (10 Cir. 1952), and quoted a portion of the decision at 197 F. 2d 18 and 19 as follows:

"But an inventor's use of his device or apparatus for experimental purposes is not public use within the intent and meaning of the statute. A use necessarily open to public view is not a public use in the sense of the statute, if it is made in good faith solely for the

purpose of testing the qualities or operation of the invention. * * * The determinative factor is whether the use is made in good faith for purposes of experiment in testing the qualities and operation of the device or apparatus. [citing cases] * * * And use by an inventor in good faith for the purpose of testing his apparatus or device for experimental purposes is not public use within the scope of the statute, even though incidental to such use he derives some financial return. Good faith use of an invention for such purpose is not changed in character merely by the receipt of incidental profit or gain." (Appendix 17a.)

Immediately following the portion of the decision quoted by the District Court, the decision in *Merrill v. Builders Ornamental Iron Co., supra,* continues:

"But when use is shown more than the statutory period antedating the filing of the application for the patent, it is incumbent upon the patentee to show that such use was experimental only."

After quoting the decision in the *Merrill* case, *supra,* the District Court noted (Appendix 18a) the circumstances surrounding the use including the extent of the use, the changes and modifications resulting from the use, the complicated nature of the machine and the necessity of testing the machine and held:

"* * * a much longer period than the six-week spent on the Ravenna project '* * * could hardly be regarded as excessive for testing the function and utility of a rather complicated machine, newly conceived and newly constructed and for experimentation looking toward essential changes and adjustments.' Long Mfg. Co. v. Holliday, 246 F. 2d 95, 102 (4th Cir. 1957). We find no difficulty in holding that the use of the machine prior to May 15, 1943 '* * * may be properly characterized as substantially for the purposes of experiment.' Smith & Griggs Mfg. Co. v. Sprague,

123 U. S. 249, 256, 8 S. Ct. 122, 126, 31 L. Ed. 141 (1887), '* * * made in good faith * * * in testing the qualities and operation of the device or apparatus.' Merrill v. Builders Ornamental Iron Co., supra, 197 F. 2d at 19." (Appendix 19a.)

When setting forth its conclusions the District Court further stated, Appendix 43a, 44a:

"The defendant has failed to overcome the presumption of the patent's validity. This presumption is clearly stated in the cases and in the statute. 35 U. S. C. § 282; Admiral Corp. v. Zenith Radio Corp., 296 F. 2d 703 (10th Cir. 1961); Bewal, Inc., v. Minnesota Mining and Mfg. Co., 292 F. 2d 159 (10th Cir. 1961).

"Defendant has sought to overcome the presumption of validity by attempting to show: that the patent was in 'public use' for more than one year prior to the application; that the machine represented merely an aggregation of old elements disclosed in prior art; that the claims did not contain sufficient novelty and invention as to be patentable; and that the invention was not described with sufficient particularity as to enable one skilled in the art to construct the machine.

"Essentially, the Court has found against the defendant on each of these primary contentions.

"Although the invention saw some limited use for more than one year prior to the application, it was not in 'public use' within the intended meaning of 35 U. S. C. § 102(b)."

Petitioner did not request the District Court to reconsider its decision as to public use because of an alleged application of an improper presumption as to the patent's validity nor did petitioner argue to the Court of Appeals that any improper presumption of validity had been applied by the District Court. Moreover, the record contains

no evidence concerning the extent of use of Ravenna before May 15, 1943 except that some use was made, nor does the record contain any evidence of the minimum amount of testing which must be done to establish a reduction to practice of the invention. A public use in contravention to the statute cannot begin to run until an invention is reduced to practice by sufficient testing to show that the invention is capable of performing its intended function. *Coffin v. Ogden*, 85 U. S. (18 Wall.) 20, 21 L. Ed. 821 (1874). The burden of proving sufficient testing to establish a reduction to practice was Petitioner's.

ARGUMENT.

QUESTION NO. I.

A. NO UNSETTLED QUESTION OF FEDERAL LAW.

Question No. I does not involve an unsettled question of Federal Law but on the other hand involves a well settled and long established doctrine of law. In its first question Petitioner asks whether the long accepted and well established law of the *Elizabeth v. Pavement Co., supra*, is applicable today. This does not raise a question as to application of the law in this case, see *Crown Cork and Seal Co. Inc. v. Ferdinand Gutmann Co. Inc.*, 304 U. S. 159, 58 S. Ct. 842 (1938); *General Talking Pictures Corporation v. Western Electric Co.*, 304 U. S. 546, 58 S. Ct. 849 (1938), but only a question as to whether or not the law is applicable.

The *Elizabeth* case stated that the use of an invention in public for experimental purposes does not contravene the patent statutes and constitute a public use such as would bar an application for patent under 35 U. S. C. § 102(b) if the use occurred more than one year before the filing date of the application. At the time of the *Eliza-*

beth case, the statutes allowed two years before the application had to be filed.

The rule of the *Elizabeth* case was recognized and restated by this Court in *Smith & Griggs Mfg. Co. v. Sprague*, 123 U. S. 249, 8 S. Ct. 122, 31 L. Ed. 141 (1887) as follows:

> "A use by the inventor, for the purpose of testing the machine, in order by experiment to devise additional means for perfecting the success of its operation, is admissible; and where, as incident to such use, the product of its operation is disposed of by sale, such profit from its use does not change its character * * * The thing implied as excepted out of the prohibition of the statute is a use which may be properly characterized as substantially for purposes of experiment.
>
> * * * * *
>
> "On the other hand, the use of the invention by the inventor himself, or by another person under his direction, by way of experiment, and in order to bring the invention to perfection, has never been regarded in this court as such a public use as under the statute defeats his right to patent * * * In Elizabeth v. Pavement Co., 97 U. S. 126, 134, it was said: 'When the subject of invention is a machine, it may be tested and tried in a building either with or without closed doors. In either case, such use is not a public use, within the meaning of the statute, so long as the inventor is engaged, in good faith, in testing its operation. He may see cause to alter it and improve it, or not. His experiments will reveal the fact whether any and what alterations may be necessary. If durability is one of the qualities to be attained, a long period, perhaps years, may be necessary to enable the inventor to discover whether his purpose is accomplished. And yet he may be justly said to be

> using his machine only by way of experiment; and no one would say that such a use, pursued with a bona fide intent of testing the qualities of the machine, would be a public use within the meaning of the statute. * * * While the supposed machine is in such experimental use, the public may be incidentally deriving a benefit from it.'" 123 U. S. 256-258.

The experimental use doctrine was recognized by this Court as late as 1939 in *Electric Storage Battery Co. v. Shimadzu,* 307 U. S. 5, 59 S. Ct. 675; where *Elizabeth v. Pavement Co., supra,* was cited and it was stated at 307 U. S. 15 that a mere experimental use is not the public use defined by the Act.

There is no question but what the law of experimental use as expressed in *Elizabeth v. Pavement Co., supra,* is clearly in the public interest in that it encourages the perfecting and completion of an invention before a patent application is filed. If the rule were otherwise, inventors would be forced in many cases, where it is necessary to test the invention in public to determine whether or not it is capable of performing its intended function and accomplishing its purpose, to file patent applications before the invention has been proved useful or fully developed. Consequently, inventors would be forced to file incomplete disclosures, contrary to the purpose of the patent statutes and the Patent Office would receive an increased load resulting from applications on unproven inventions and an increased number of worthless "paper" patents would result. See comments of this Court concerning the filing and issuance of patents in *Graham v. John Deere Company of Kansas City,* 86 S. Ct. 684, 694 (1966).

The necessity of allowing an inventor to experiment was recognized in *Ushakoff v. United States,* 327 F. 2d 669 (Ct. Cl. 1964), at page 672:

> "On the other hand, the law has recognized the necessity of allowing an inventor to freely experiment with his invention and permits such experimental use which is reasonably necessary to the perfection of the invention * * * this exception has been recognized even in cases where the experimental use has resulted in incidental profit to the inventor."

It is respectfully submitted that Petitioner has shown no reason why this Court should grant certiorari to overrule the long established and accepted law on experimental use.

Moreover, Congress has given its tacit approval to this doctrine. Congress passed the Patent Act of 1952, 35 U. S. C., without showing any concern about the law in this field as delineated by the decisions of this Court. If Congress had felt that the decisions of this Court were contrary to public policy, as urged by Petitioner, the Patent Act of 1952 was a ready-made opportunity to change any such doctrines. Congress, however, did not see fit to change the law as enunciated by this Court.

Lower Courts Correctly Applied Law.

The District Court considered all of the evidence before it and found, as a finding of fact, that the use at Ravenna was experimental use and not public use. The court noted the extent of the use, the necessity for testing the machine of the patent, the facts with respect to changes which were made during testing period, the improvements which resulted from the testing period, and had before it the testimony of one of the inventors as to the character of the use at Ravenna (see above pp. 6-12). These are all factors which this Court noted in *Elizabeth v. Pavement Co., supra.* In that case, the invention involved a strip of pavement which was laid as a road to the entrance of a toll

gate and was used by users of the toll road for six years prior to the filing of the application. This Court noted the necessity of testing road pavement to determine its durability and capability of performing its function. It also noted that the road was observed during its use by the inventor and was in effect under his control. All the criteria noted by the *Elizabeth* case are present in the instant case except possibly the statement of a witness other than the inventor. However, in the instant case there is documentary evidence showing the structures which were used, the changes which were made, and the extent of the use (See above, p. 7). This evidence is undisputed.

This is not a situation similar to the *Barbed Wire Patent Case*, 143 U. S. 275 (1892), relied on by Petitioner as setting a standard for the type of evidence which should be present. In that case the structure which allegedly was in public use was disputed and only conflicting oral testimony was before the court. Obviously the case has no similarity to the present case.

Clearly the lower court cannot be said to have acted contrary to the decisions of this Court in finding experimental use.

The Petitioner argues that its Exhibit W, Sub-exhibit E, Appendix 70a, proves that the use was not experimental. Suffice it to say that the inventors in that paper merely stated that the Gradall did perform as required on that particular job and that the job could not have been done in the same period if the Gradall had not been there. This obviously does not mean that the use was not experimental or that the work could not have been done if the Gradall had not been there.

Not only did the lower courts correctly apply the law of experimental use but there can be no public use in contravention to the patent statutes until the invention is

reduced to practice by sufficient testing to show that the invention can perform its intended function and its capability of being used for its intended purposes. *Coffin v. Ogden, supra.* The burden of proving sufficient testing establish reduction to practice so that a public use could occur was Petitioner's. See *Lyon v. Bausch & Lomb Optical Co.*, 224 F. 2d 530 (2 Cir. 1955); *Aerovox Corp. v. Polymet Mfg. Corporation*, 67 F. 2d 860 (2 Cir. 1933).

No Conflict of Decisions.

In its Petition, pages 9-11, Petitioner apparently argues that there is a conflict among the lower courts concerning the law with respect to experimental use. Respondents have found no such conflict among the circuits and in fact, the Court of Customs and Patent Appeals has specifically commented upon the uniformity concerning this phase of the law. In *Application of Josserand*, 188 F. 2d 486 (C. C. P. A. 1951), the court, after discussing the facts in *Elizabeth v. Pavement Co., supra*, and noting the statement of this Court that any attempt to use the claimed invention for profit and not by way of experiment would deprive the inventor of his right to a patent, stated:

> "So far as we can determine from a study of all the judicial decisions found, the thoughts so expressed has been regarded uniformly by all Courts, which have had occasion to pass upon the question, as a correct statement of the law." (p. 493.)

The uniformity in the various circuits in following *Elizabeth v. Pavement Co.* is shown by the following decisions:

First Circuit: *Atlas v. Eastern Airlines, Inc.*, 311 F. 2d 156 (1962); *National Biscuit Co. v. Crown Baking Co.*, 105 F. 2d 422 (1959).

Second Circuit: *Lyon v. Bausch & Lomb Optical Co., supra; General Electric v. Minneapolis-Honeywell Regulator Co.*, 118 F. 2d 278 (1941).

Third Circuit: *Wilkie v. Manhattan Rubber Mfg. Co.*, 14 F. 2d 811 (1926).

Fourth Circuit: *Nicholson v. Carl W. Mullis Engineering & Mfg. Co.*, 315 F. 2d 532 (1963); *Long Mfg. Co. v. Holliday*, 246 F. 2d 95 (1957), cert. denied, 355 U. S. 926, 78 S. Ct. 384, 2 L. Ed. 357 (1958); *Thompson v. The American Tobacco Company*, 174 F. 2d 773 (1949); *Lanham v. Southern Bakeries Co., Inc.*, 198 F. Supp. 926 (D. C. N. Ga. 1960), aff'd 295 F. 2d 816 (1961).

Fifth Circuit: *Adams v. Columbus Manufacturing Co.*, 180 F. Supp. 921 (D. C. M. D. Georgia 1960).

Sixth Circuit: *Goodwin v. Borg-Warner Corporation*, 157 F. 2d 267 (6th Cir. 1946), cert. denied 329 U. S. 799.

Seventh Circuit: *Hobbs v. Wisconsin Power & Light*, 250 F. 2d 100 (1957), cert. denied 356 U. S. 932; *Barie v. Superior Tanning Co.*, 182 F. 2d 724 (1950); *Randolph v. Allis-Chalmers Mfg. Co.*, 120 U. S. P. Q. 522, 264 F. 2d 533 (1959).

Eighth Circuit: *Grand Rapids Showcase Co. v. Measuregraph Co.*, 28 F. 2d 497 (1928).

Ninth Circuit: *Cataphote Corp. v. De Soto Chemical Coatings, Inc.*, 235 F. Supp. 931 (N. D. Calif. 1964); *Kierluff v. Metropolitan Stevedore Co.*, 221 F. Supp. 830 (S. D. Calif. 1963); *Schmeiser v. Thomasian*, 227 F. 2d 875 (1955).

Cases Cited by Petitioner Not in Point.

The cases cited by Petitioner, Petition pp. 10, 11, for showing that there is nonuniformity in the application of the law of experimental use are not in point. The decisions did not involve the simple issue as to whether the use was experimental or mainly for profit. The patentees in the cases relied upon by Petitioner were arguing in each case that a secret use mainly for profit is not a public use. In fact, the court in *Huszar v. Cincinnati Chemical Works*, 172 F. 2d 6 (6th Cir. 1949), relied upon by Petitioner, noted that there was no allegation that the use for profit was experimental, only that it was secret.

In *Metallizing Engineering Co. v. Kenyon Bearing & Auto Parts Co.*, 153 F. 2d 516 (2nd Cir. 1946), also relied upon by Petitioner, it is clear that Judge Learned Hand was deciding the effect of a secret use for profit and not whether or not the use was experimental. Moreover, it is clear from a consideration of the decision in *U. S. Chemical Corp. v. Plastics Glass Corp.*, 243 F. 2d 892 (3rd Cir. 1957), cert. denied 357 U. S. 836 (1957), and from the decision of the District Court in the same case, 142 F. Supp. 840, that the issue again was primarily whether or not a secret use mainly for profit would bar a patent. In its Petition for Certiorari, Case No. 338, October 1957 Term, the appellant in *U. S. Chemical Corp. v. Plastics Glass Corp., supra,* directed its argument to the proposition that Judge Learned Hand's decision in the *Metallizing* case and the Court of Appeals' decision in that case should be overruled since a secret use mainly for profit was not a public use within the meaning of the Patent Statutes. While the question of experimental use versus use for profit was raised, the remainder of the petition only referred to the experimental use question to state that

experimental use would be argued if certiorari were granted.

From the foregoing, it is clear that Petitioner has not shown that the Second, Third and Sixth Circuits have views different from the other circuits on the question of experimental use. In fact, the situation in the present case is very similar to that in *General Electric v. Minneapolis-Honeywell, supra,* decided by the Court of Appeals for the Second Circuit.

No Constitutional Question Involved.

Petitioner suggests that any experimental use in public extends the monopoly contrary to the Constitution which provides the monopoly should be for limited times. Obviously the patent grant is limited to 17 years from the date of issuance of the patent and therefore is necessarily for a limited time. The inventor has no monopoly before the patent is granted. Moreover, under *Elizabeth v. Pavement Co., supra,* and the other cases involving experimental use, experimental use can only extend for that time reasonably necessary to perfect the invention. Consequently there can be no unlimited experimental use.

Conclusion as to Question I.

It is clear from the foregoing that the law as expressed in *Elizabeth v. Pavement Co., supra,* relative to experimental use is valid today and that it was properly applied in the instant case. Moreover, the rule must clearly be presumed to be within the intent of Congress since Congress did not attempt to modify or change the rule when it passed the 1952 Patent Act which codified existing law as well as changing the law in areas where Congress felt that the decisions of this Court were not in accordance with their intent.

QUESTION II.

There is no basis in the record for stating that the District Court applied a presumption of validity when deciding the issue of public use. Therefore, the issue raised by Petitioner in Question No. II is a purely hypothetical question. Moreover, the District Court would have been justified in applying a presumption of validity since Petitioner failed to establish that a *completed invention* was in "public use."

District Court Applied No Presumption.

In support of its position, Petitioner on page 14 of its Petition refers to the following language of the District Court:

> "The defendant has failed to overcome the presumption of the patent's validity * * * defendant has sought to overcome the presumption of validity by attempting to show: that the patent was in 'public use' for more than one year prior to the application * * *." (Appendix 43a-44a.)

The language upon which Petitioner bases its argument that the court applied a presumption is in the portion of the decision where the court states its general conclusions. The discussion of the issue of public use appears earlier in the decision at pages 15a-19a of the Appendix and it is clear from a consideration of this portion of the decision that the District Court did not apply a presumption in favor of Respondents.

The District Court, after stating the issue concerning public use at Appendix page 8a, concluded "After full consideration of the evidence" that "the use here falls within the rule of the Merrill case and does not contravene in the purpose of the statute." After stating this conclusion, the District Court continued (Appendix 18a) to review the

significant evidence which led to this conclusion, noting the time of the use, the circumstances of the use, the general problem involved with the machine, the other equipment utilized on the construction job, the necessity of testing a machine of this type extensively under actual working conditions, the absence of any evidence showing the use of this machine was a factor bargained for in letting the construction contract at the Ravenna Arsenal to the inventors of the machine, the showing that modifications were made during this period of use and the showing that the experience obtained from the use led the inventors to make additional modifications and improvements thereafter and the like.

After this review of the evidence, the District Court concluded:

> "We find *no difficulty* in holding that the use of the machine prior to May 15, 1943 '* * * may be properly characterized as substantially for the purposes of experiment.'" (Appendix 19a. Emphasis supplied.)

Clearly, then, the District Court found experimental use only after a full consideration of the evidence. Its statement that there was no difficulty in holding the use experimental clearly indicates that the District Court did not apply a presumption in arriving at its finding.

While Petitioner is arguing to this Court that a presumption was improperly applied in finding experimental use, Petitioner made no request for reconsideration after the District Court rendered its opinion.

Court of Appeals' Argument and Decision.

Not only did Petitioner fail to ask reconsideration of the District Court's opinion but Petitioner also failed to argue this point to the Court of Appeals for the Tenth

Circuit. While Petitioner did argue to the Court of Appeals that the finding of experimental use was unsupported by the evidence, at no time did Petitioner present an argument that the District Court had improperly applied a presumption of validity in finding that the invention had not been in public use. Moreover, it does not appear from the record that the Court of Appeals applied any presumption in finding experimental use.

Application of the Presumption of Validity Proper.

In presenting its argument in support of Question No. II, Petitioner assumes that the District Court found that the invention had been completed and then used in public some time between mid-March 1943 and May 15, 1943. Before an invention can be in "public use" within the meaning of 35 U. S. C. § 102(b), it must have been reduced to practice and a reduction to practice includes the testing necessary to show that the invention is capable of performing its intended function. *Coffin v. Ogden, supra; Aerovox Corporation v. Polymet Mfg. Corp., supra; Robinson on Patents* (1890), Vol. 1, § 318, p. 426.

There is nothing in the record of the instant case to establish that there was sufficient use of the invention between mid-March 1943 and May 15, 1943 to show that the invention was capable of performing its intended function and purpose prior to May 15, 1943. The record only shows that the machine was used for a six-week period between mid-March and mid-June and that the machine was down for about 25% of that time. Nor does the record support any argument that a test period of less than the six weeks would constitute a reduction to practice.

Clearly, then, the record in the instant case does not establish that there was sufficient testing before May 15, 1943 to constitute a completion of the invention. It was Petitioner's burden to show that the use before May 15, 1943 was sufficient to show that the machine was capable of performing its intended purpose and function and until this is shown, the presumption of validity accorded the statute is not overcome. See *Lyon v. Bausch & Lomb Optical Co., supra.* Consequently, the District Court would have been justified, on the record, in applying a presumption in favor of validity.

Conclusion as to Question No. II.

It is respectfully submitted that the record shows that no presumption was applied by the District Court in making its finding of experimental use but that the application of such a presumption would have been justified since the Petitioner failed to prove that a completed invention was in use before May 15, 1943.

It is respectfully submitted that the record of this case furnishes no basis for a grant of certiorari to review the law on presumptions of validity provided for by 35 U. S. C. § 282.

CONCLUSION.

For the foregoing reasons it is respectfully submitted that the petition for writ of certiorari should be denied.

Respectfully submitted,

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ANNEX A.

Claims 8, 9 and 16 from Patent in Suit, Exhibit 1.

8. Apparatus comprising a base, a boom mounted on said base for sluing, mechanism for sluing said boom, said boom having a base section and an extensible section telescopically mounted on said base section, mechanism to extend and retract said extensible section, an implement attached to the free end of said extensible section and having a working edge, said implement having a mounting on said extensible section including a linear pivot extending cross-wise of said boom, means for holding said implement in various positions about said pivot, said base section having a transverse pivotal mounting, mechanism for tilting said base section about said pivotal mounting, means mounting said base section for oscillation about an axis extending longitudinally of said boom, said extensible section being mounted non-oscillatably about said axis relative to said base section; and mechanism for oscillating said base section about said axis.

9. Apparatus comprising a base, an annular track having a horizontal pivotal mounting on said base, a telescoping boom having a base section and an extensible section slidable longitudinally of said base section, said base section having an annular bearing in said track so arranged that said base section of said boom is held against longitudinal movement relative to said annular track, power means operatively connected between said base and said base section of said boom for tilting said boom about said horizontal pivotal mounting, power means operatively connected between said base section and said annular track for oscillating said boom in said bearing about an axis longitudinal of said boom, mechanism operatively connected between said base section and said extensible section for

extending and retracting said extensible section of said boom, and an implement attached to the free end of said extensible section in fixed orientation about the longitudinal axis of said extensible section.

16. An apparatus of the character described having in combination a support, a platform pivotally mounted on said support, hydraulic means for rotating said platform acting between said platform and said support and operative through an angle of not less than 180 degrees of circular movement around its pivot, a telescoping boom comprising a base section and an extensible section, means mounting said base section on said platform for boom oscillation about an axis longitudinal of the boom, a horizontal pivot for said base section mounted on said platform, hydraulic means for tilting said base section about said horizontal pivot, hydraulic means for rotating said boom base section axially, hydraulic means for extending said extensible boom section, a material moving implement pivotally mounted on said extensible section, and means for moving said implement about its pivotal mounting.

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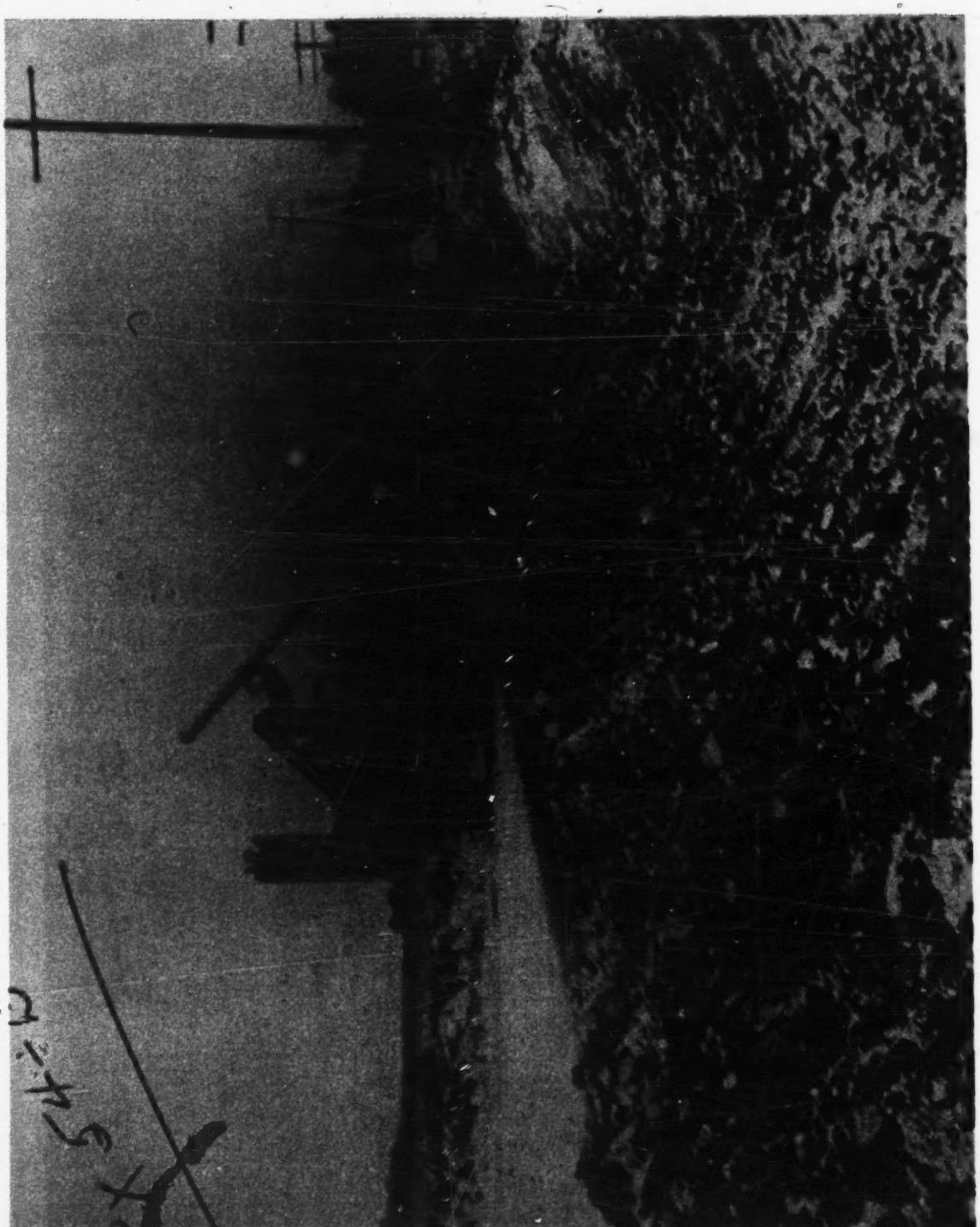
ANNEX B.

Exhibit 54-A, First Ferwerda Machine Applied in the Fall of 1942.

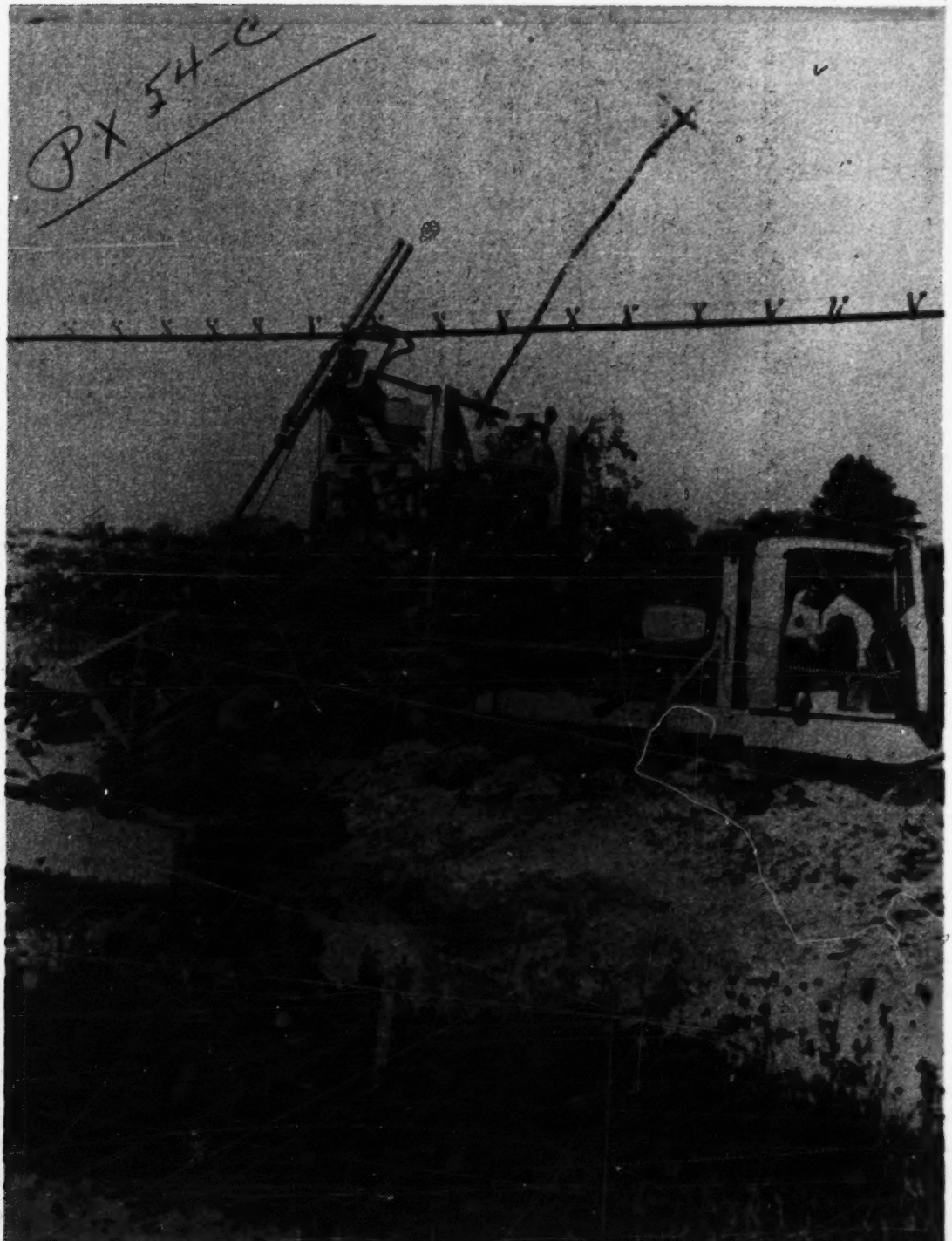
ANNEX C.

Exhibit 54-B, Ferwerda Machine as Originated at Ravenna.



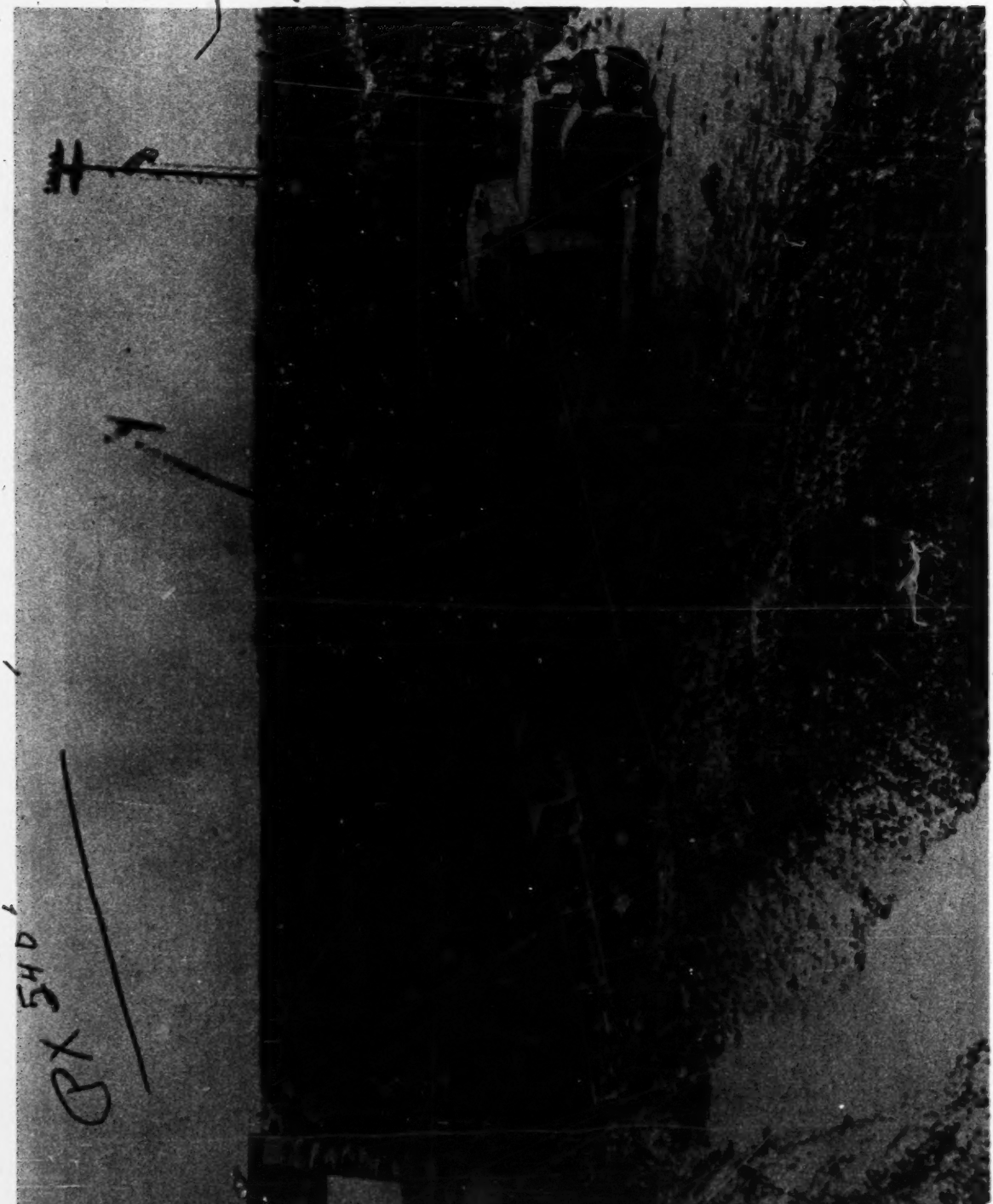
ANNEX D.

Exhibit 54-C, Ferwerda Machine at Ravenna with Base Edge.



ANNEX E.

Exhibit 54-D, Ferwerda Machine at Ravenna with Lift Cylinder Re-positioned.



ANNEX F.

Excerpts from Exhibit W, Interrogatories Concerning Structure of Ravenna Machine.

Q. 21. If the answer to Interrogatory 20 is yes, did the outer section have an annular bearing cooperating with an annular track?

A. The full details of the bearing mounting for the boom are not known except to state that the outer boom section was cantilevered at its rear end from the upper works of the machine by means of two parallel plates, one supported by the boom, the other supported by the carrier, and one of the plates carried a central hub cooperating with a hole in the other plate.

Q. 22. If the answer to Interrogatory 21 is yes, did the annular bearing cooperate with the annular track to prevent longitudinal movement of the outer section?

A. The manner in which the boom was limited against longitudinal movement is not known but it is believed to have involved retaining means associated with the hub.

Q. 23. If the answer to Interrogatory 21 is no, what structure was incorporated for rotatably mounting the outer section of the boom for rotation about its longitudinal axis?

A. See the answer to Interrogatory 21.

Q. 24. If the answer to Interrogatory 6 is yes, did the machine illustrated in Exhibits A, B, C and D have a boom which was raised and lowered by hydraulic means?

A. Yes.

Q. 25. If the answer to Interrogatory 20 is yes, did the machine illustrated in Exhibits A, B, C and D have hydraulic means for rotating the outer section of the boom about its longitudinal axis?

A. Yes.

Q. 26. If the answer to Interrogatory 6 is yes, could the blade or working tool mounted on the end of the boom be moved about an axis extending transversely of the boom?

A. No.

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